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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,383	11/04/2003	Jean-Francois Savouret	RICL-110 (69769-011)	5818

7590 06/21/2005
Mark G. Lappin
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EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,383

Applicant(s)

SAVOURET ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 14-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/4/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1-25 are pending.

Claims 1-8 and 10-13 are rejected.

Claims 9 and 14-25 are withdrawn from consideration.

Election/Restrictions

2. Applicant's election without traverse of Group I, claims 1-8 and 10-13 in the reply filed on May 2, 2005 is acknowledged.

3. Applicant's further elected species (E)-1-(4'-methoxyphenyl)-2-(3,5-dichlorophenyl)-ethene in a phone conversation with Mark G. Lappin on June 1, 2005.

4. Claims 9 and 14-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 2, 2005.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

7. The information disclosure statement (IDS) submitted on November 4, 2003 has been considered by the examiner.

Claim Objections

8. Claims 7 and 11 are objected to because of the following informalities: In claim 7 the compound (E)-1-(4'-trifluoromethylphenyl)-2-(3,5-ditrifluoromethylphenyl)-ethene is missing the closing parenthesis after (3,5-ditrifluoromethylphenyl; and the compound (E)-1-(4'-chlorophenyl)-2-(3,5-dichlorophenyl)-ethene is missing the closing parenthesis after (3,5-dichlorophenyl; in claim 11 the term "pharmaceutically" should be changed to "pharmaceutical". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim

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indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 13 recites the broad recitation a dosage from 0.1 mg to 5 g/day, and the claim also recites especially from 20 to 200 mg/day and in particular from 10 to 100 mg/day, which is the narrower statement of the range/limitation.

12. Claim 13 is further indefinite because although the claim appears to be directed to pharmaceutical compositions, it is written with a method step. Thus it is unclear as to whether claim 13 is a pharmaceutical composition claim or a method of administering the pharmaceutical compositions.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-5 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Suga (US 5,530,030).

Suga teaches a compound and composition comprising the compound having the claimed formula I, wherein R3 and R4 are Cl, R5 is H, R3' is OH or OMe, and R4' and R5' are H (see Table 1, in particular compound 6 and its methoxy form; and column 3, lines 46 to column 4, line 10). Suga also teaches a compound and composition comprising the compound having

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the claimed formula I, wherein R3 and R5 are Cl, R4 is H, R3' is OH or OMe, and R4' and R5' are H (see Table 1, in particular compound 7 and its methoxy form; and column 3, lines 46 to column 4, line 10). The Examiner believes that the amounts disclosed in Table 3 are within the claimed dosage range (based upon the average man's weight of 70 kg).

15. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Letcher, R. M. (Org. Magn. Reson., Vol. 16, No. 3, 1981, pages 220-223).

Letcher teaches a compound having the claimed formula I, wherein R3 and R5 are Cl; R4, R3' and R5' are H, and R4' is Cl (see document XP-002232735, supplied by Applicants).

16. Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Moylan et al. (MCLC S& T, Section B: Nonlinear Optics, Vol. 8, No. 1, 1994, pages 69-78).

Moylan et al. teach a compound having the claimed formula I, wherein R3, R4, R4' and R5' are H; R5 is MeO and R3' and R5' are F (see document XP-002232740, supplied by Applicants).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 1-5 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masahiko et al. (JP 51-136826).

Masahiko et al. disclose plant growth regulators which are the cis isomers of the compounds having the claimed formula I (see compound 7 on page 186 and attached English abstract). These compounds are disclosed in the form of oils.

The instant compounds are obvious over the compounds of Masahiko et al. because of their close structural similarity. Normally a *prima facie* case of obviousness is based upon structural similarity, *i.e.*, an established structural relationship between a prior art compound and the claimed compound. Structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties. Similarly, a known compound may suggest its analogs or isomers, either geometric isomers (*cis* v. *trans*) or position isomers. See

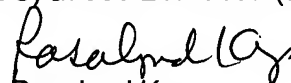
In re Deuel (CA FC) 34 USPQ2d 1210 (3/28/1995).

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalynd Keys
Primary Examiner
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June 17, 2005